

### **REMARKS**

Claims 1-26 are pending in the present application. By this Reply, Applicants have amended claims 1, 2, 5, 13, 19 and 21-23. Accordingly, claims 1-26 remain at issue.

The Examiner objected to the drawings as failing to show various reference numerals described in the specification. The Examiner also objected to various informalities in the specification. The Examiner rejected: claims 1-6 and 8-26 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,941,229 issued to Schlosser ("Schlosser") in view of U.S. Patent No. 3,766,863 issued to Swick, Jr. et al. ("Swick"); claim 7 under 35 U.S.C. §103(a) as being unpatentable over Schlosser in view of Swick, and further in view of U.S. Patent No. 5,251,973 issued to Hazan ("Hazan"). Applicants respectfully traverse these rejections.

In view of the Amendments and Remarks herein, Applicants believe the present application is in condition for allowance and respectfully requests notice of same.

#### **Objection to the Drawings**

The Examiner objected to the drawings as failing to show various reference numerals. In view of the amendments above, replacement figures included herewith and discussion below, Applicants respectfully submit that this objection has been mooted.

(a) The Examiner stated that Figure 3 fails to show reference numeral "70a". Applicants have submitted a replacement sheet to amend Figure 3 to include reference numeral "70a".

(b) The Examiner stated that Figure 6 fails to show reference numeral "30." Reference numeral "30" is shown in several other Figures, including Figures 1 and 3. Applicant has amended the specification above to clarify this.

(c) The Examiner stated that Figure 6 fails to show reference numerals "P1", "P2" and "C0". Applicants have amended the specification to reference Figures 7 and 8, and Applicants have submitted a replacement sheet to amend Figures 7 and 8 to include reference numerals "P1" and "P2". Additionally, Applicant has amended the specification above to clarify that reference numeral "C0" is not shown.

(d) The Examiner stated that Figure 12 fails to show reference numeral "306."

Applicants respectfully disagree and request the Examiner to review Figure 12, as reference numeral "306" is specifically shown in Figure 12 as originally submitted (see reference numeral "306" to the left of the rear wheels of the grill assembly).

In view of these amendments and remarks, Applicants respectfully submit that this objection has been mooted.

#### Objection to the Specification

The Examiner objected to various portions of the disclosure because of certain informalities. Applicants have amended the specification above to eliminate the Examiner's objections. In view of these amendments, Applicants respectfully submit that this objection has been mooted.

#### Rejection of Claim 1-6 and 8-26 under 35 U.S.C. §103(a)

The Examiner rejected claims 1-6 and 8-26 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,941,229 issued to Schlosser et al. ("Schlosser") in view of U.S. Patent No. 3,766,863 issued to Swick Jr. et al. ("Swick"). Applicants respectfully traverse this rejection.

The Examiner has asserted that Schlosser generally discloses a barbecue grill frame assembly having a shelf depending between a plurality of leg and cross members. The Examiner further asserts that Swick teaches a shelf having a bottom wall, a sidewall, and "quick release spring like members (42) that snap fit onto a cross member (22) in a first position and in a second position when it is removed from the cross member." (Page 4 of Office Action). Accordingly, the Examiner concluded that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the shelf of Schlosser with the provision of a shelf as taught by Swick in order to arrive at the Applicants' invention. Applicants respectfully traverse this rejection.

As shown below in more detail, the Examiner's rejections are improper for at least three reasons: (a) the Examiner has failed to present a *prima facie* case of obviousness; (b) the Examiner has improperly used hindsight gained through Applicants' invention to arrive at the present rejections; and, (c) notwithstanding that the Examiner has failed to present a *prima facie* case of obviousness and has improperly utilized hindsight in the present rejection, the references cited by the Examiner do not disclose or suggest each of the limitations of the claims and as such, the claims are patentable over the cited references. Thus, the rejection is not only improper but it is invalid.

First, it is the burden of the Patent and Trademark Office to establish a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. §103. In re Reuter, 210 USPQ.2d 249 (CCPA 1981). To establish a *prima facie* case of obviousness, three basic criteria must be met: first, there must be some suggestion, incentive or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art references must teach or suggest all the claim limitations. See In re Geiger, 815 F.2d 686, 688 (Fed. Cir. 1988). Obviousness cannot be established by combining the teachings of a reference to produce the claimed invention, absent some teaching or suggestion supporting the combination of the references. ACS v. Montefiore Hospital Systems, Inc., 221 USPQ 929, 933 (Fed. Cir. 1984). Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the Applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991).

Here, as quoted from Schlosser, its invention "relates generally to barbecue grills, and more particularly, to support frames and accessory work surfaces for gas barbecue grills." (Schlosser, Col. 1, lines 5-8.) In contrast, the disclosure of Swick relates to "display apparatus and, more particularly, to a quickly assembled and disassembled display shelf apparatus which is especially useful in retail establishments, such as supermarkets, drug stores and hardware stores, wherein there is a constant requirement for temporary additional display shelving." (Swick, Col. 1, lines 2-8.) Accordingly, it is clear that these references relate to vastly different arts and have

vastly different applications. As is seen on the face of the respective patents, none of the art classes or fields of search for the two patents overlap because they relate to such different technologies. Moreover, there is no teaching or suggestion in the references (other than in the Applicants' application) to make this combination. Furthermore, one of ordinary skill in the art of barbecue grill carts would not look to the display apparatus arts (such as Swick), for suggestions and teachings. Thus, Applicants respectfully assert that the Examiner has improperly used hindsight (i.e., the teachings of Applicants' invention) to obtain the combination. Thus, this combination of references violates Federal Circuit law. Accordingly, Applicants respectfully submit that since there is no teaching or suggestion to combine the disclosures of Schlosser and Swick, the Examiner has failed to present a *prima facie* case of obviousness. For this reason the Applicants respectfully submit that this rejection is improper and should be withdrawn.

Notwithstanding, Applicants assert that even if the two references were properly combinable, they do not render Applicants claims unpatentable as being obvious over the prior art. As originally presented and/or currently amended, Applicants' claims require at least:

- (a) a first quick release member secured to the first sidewall, the first quick release member having a detent that secures the shelf to the barbecue grill frame assembly (independent claim 1);
- (b) a plurality of sidewalls depending from the bottom wall, the sidewalls having an upstanding portion and a transverse portion, and a first spring member secured to the first of the plurality of the sidewalls; (independent claim 10);
- (c) a quick release member having a detent extending therefrom, wherein the detent of the quick release member secures the shelf to the barbecue grill frame assembly in a first position (independent claim 18);
- (d) a detent extending from a downturned portion of a sidewall, the detent engaging the cross member of the barbecue grill frame assembly (independent claim 21);

In the Office Action the Examiner stated that Swick "teaches a shelf having a bottom wall (24) a first sidewall, a second sidewall locates opposite from the first sidewall, the first and second sidewalls each has a quick release spring like members (42) that snap fit onto a cross

member (22) in a first position and in a second position when it removed from the cross member." This is not correct. As is seen its specification, Swick discloses a shelf (14) that has the following structure:

The opposite edge sides B,B' are folded along crease lines 30,32 and 34 in order to define structure for cooperating with the horizontal support members 22. Each side portion B,B' is first folded 90° upwardly about the line 30, after which the edge portion is folded 90° in the opposite direction (downward) about the hinge line 32, followed by the subsequent folding of the side edge portion about the crease line 34 downwardly 90°. The result is a U-shaped clip portion, designated by the numeral 42 in FIG. 3, with the clip portion being of rectangular cross-section corresponding to the rectangular cross-section of the horizontal support member 22. (Swick, Col. 2, lines 51-63.) (Emphasis added.)

Thus, contrary to the Examiner's assertion, element 42 of Swick is not a "quick release spring like member" that is secured to the sidewall of the shelf. Rather, Swick discloses that element 42 is a U-shaped member that is formed by bending the side-edge portion of the temporary shelf. The U-shaped member merely fits over the top of a square bar stock that forms a cross member on the temporary shelving supports of Swick. Accordingly, the U-shaped member (42) is not secured to the sidewall as asserted by the Examiner – instead it is the sidewall of the shelf. Accordingly, the Applicants' respectfully assert that the Examiner's interpretation of Swick is inaccurate and merely uses hindsight gained by Applicants' disclosure in an attempt to turn the disclosure of Swick into something that it is not. As shown above, it is clear that Swick does not have a quick release member secured to the sidewall of the shelf.

Moreover, Swick does not disclose a quick release member that moves from a first position, where the shelf is positively secured to the barbecue grill frame, to a second position, where the shelf can be removed. This is a very important distinction. Unlike Swick, where the display apparatus remains in a fixed place in a store, barbecue grills are moved from location to location, often on bumpy grassy grounds, and the shelf must be positively held in place or it will dislodge. The apparatus of Swick provides no quick release member to positively secure in place, and to move from a first position to a second position. Thus, the apparatus of Swick would not even work for the intended and recited use of Applicants' invention. For these reasons

the Applicants respectfully assert that independent claim 10, and each claim dependent thereon, are patentable over Schlosser in view of Swick.

Finally, Swick provides no disclosure for a **detent extending from the quick release member**. Applicants have amended various claims to include this limitation. As explained in Applicants' specification the "detent 311 in the engaging member 308a lockingly engages a portion of the bottom wall 336 of the cross member 326 of the barbecue grill frame assembly 302." Further, Applicants' specification states that "[t]he sidewall components in combination with the detent 311 contacting the portion of the bottomwall 336 of the cross member 326 operates to substantially prevent upward and downward movement of the shelf 300 when in the first position." Such a structure is neither contemplated nor disclosed in Swick. Thus, Applicants respectfully assert that independent claim 1, 18 and 21, and each claim dependent on thereon, are patentable over Schlosser in view of Swick. If an independent claim is non-obvious under §103, then any claim depending therefrom is also non-obvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, even if Swick were properly combinable with Schlosser, which Applicants respectfully assert it is not, the combination of these references does not disclose or render obvious Applicants' claim limitations.

**CONCLUSION**

In view of the amendments made herein and the foregoing remarks, it is submitted this application is in condition for allowance. Such action is respectfully requested. Further, the Examiner is requested to contact the undersigned if the Examiner has any questions concerning this Response or if it will expedite the progress of this application.

Respectfully submitted,

Dated: December 10, 2004

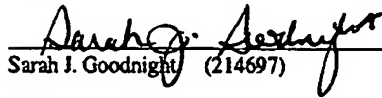
By:



Matthew J. Gryzlo, Reg. No. 43,648  
WALLENSTEIN WAGNER & ROCKEY, LTD.  
311 South Wacker Drive - 53rd Floor  
Chicago, Illinois 60606  
(312) 554-3300

**CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on December 10, 2004.



Sarah J. Goodnight (214697)